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Paper 113
Filed: 15 November 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

VINCENZO **SCARLATO**,
VEGA MASIGNANI, RINO RAPPUOLI,
MARIAGRAZIA PIZZA,
AND GUIDO GRANDI,

Junior Party
(Patent 7,714,121),

v.

IAN RICHARD ANSELM **PEAK**,
MICHAEL PAUL JENNINGS,
AND E. RICHARD MOXON

Senior Party
(Application 12/841,457)

Patent Interference No. 105,791
Technology Center 1600

Before RICHARD E. SCHAFER, RICHARD TORCZON, and SALLY GARDNER LANE,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge* LANE.

Opinion concurring filed by *Administrative Patent Judge* TORCZON.

LANE, *Administrative Patent Judge.*

Decision on Motions – Bd.R. 125(a)

I. Statement of the Case

This interference is before a motions panel for decision on Scarlato Miscellaneous Motion 1 (Paper 55), for authorization to request a Certificate of Correction of Scarlato's involved patent 7,714,121 ("the '121 patent"). See 35 U.S.C. § 254. We grant the Motion.

Junior Party Scarlato¹ is involved in the interference based on the '121 patent, which issued 11 May 2010, from application 10/695,499, filed 28 October 2003. (Paper 1 at 3.)

At declaration Scarlato² was accorded the benefit of the following applications:

- US 09/302,626 filed 30 April 1999, now patent 6,709,660, issued 23 March 2004;
- PCT/IB99/00103 filed 14 January 1999;
- UK 9822143.5 filed 9 October 1998;
- UK 9819015.0 filed 1 September 1998; and
- UK 9800760.2 filed 14 January 1998.

(*Id.* at 3.)

Count 1 of the interference recites: "An isolated nucleic acid molecule that encodes a protein comprising the amino acid sequence of SEQ ID NO: 4 of Scarlato or SEQ ID NO: 21 of Peak." (*Id.* at 4.) The sequences encode antigens that are useful in

¹ Novartis AG is the real party-in-interest of Scarlato. (Paper 9.) The University of Queensland and Glaxo SmithKline are the real parties-in-interest of Peak. (Paper 5.)

² Peak was also accorded the benefit of several applications (see Paper 1 at 5), but these applications are not at issue in regard to Scarlato Miscellaneous Motion 1.

making vaccines, immunogenic compositions, and diagnostics for the human pathogen *Neisseria meningitides*, a cause of meningitis. (See Peak Motion 1, Paper 31, p. 1; Scarlato Motion 1, Paper 34, p. 1)

In its Miscellaneous Motion 1, Scarlato seeks correction of the sequence identified as “ORF40-1” and “SEQ ID: 4” (“the ORF40-1/SEQ ID: 4 sequence”) in the ‘121 patent specification because of differences that, according to Scarlato, are typographical errors made by the Office on issue of the patent. (Scarlato Misc. Motion 1 at 1.)

The ORF40-1/SEQ ID: 4 sequence is also at issue in Peak’s Substantive Motion 1. There, Peak argues that Scarlato should be denied benefit of the earlier UK applications, 9819015.0 and 9800760.2, in part because of the differences between the ORF40-1/SEQ ID: 4 sequence in the ‘121 patent and the priority applications.³ (Peak Motion 1, Paper 31, at 5-6.)

II. Findings of Fact

1. Scarlato’s involved ‘121 patent recites a sequence for ORF40-1/SEQ ID: 4 with the symbols “X,” “b,” and “U” at positions 277, 367, and 368, respectively. (Ex. 2009, ‘121 patent, cols. 47 and 48.)

2. Application 10/695,499 (“the ‘499 application”), which became the Scarlato ‘121 patent, recites a sequence for ORF40-1/SEQ ID 4 with the symbols with the symbols “K,” “N,” and “I” at positions 277, 367, and 368, respectively. (Ex. 2017, p. 66.)

³ Peak also cites the differences in the sequences in its Substantive Motion 2, requesting substitution of Count 1. (Paper 32, pp. 8-9.)

3. PCT/IB99/00103 ("the PCT application") recites ORF40-1/SEQ ID: 4 with the symbols "K," "N," and "I" at positions 277, 367, and 368, respectively. (Ex. 2015, PCT application, p. 62.)

4. U.K. 9822143.5 ("the UK application") recites ORF40-1/SEQ ID: 4 with the symbols "K," "N," and "I" at positions 277, 367, and 368, respectively. (Ex. 2016, UK application, p. 63.)

5. The prosecution history of the '499 application does not show an amendment to the symbols of sequences recited in the specification as originally filed. (See Exs. 2018 and 2019.)

6. The Sequence Listing of Scarlato's involved '121 patent provides SEQ ID NO: 4 including "Lys," "Asn," and "Ile" at positions 277, 367, and 368, respectively. (Ex. 2009, cols. 181-184.)

7. The single and triple letter codes for the amino acids lysine, asparagine, and isoleucine are as follows.

<u>Amino Acid</u>	<u>Three Letter Code</u>	<u>Single Letter Code</u>
Lysine	Lys	K
Asparagine	Asn	N
Isoleucine	Ile	I

(Alberts et al., Molecular Biology of the Cell, 2nd Ed. (1989), back inside cover.)

8. The Sequence Listing of Scarlato's involved '121 patent recites the same amino acid sequence for SEQ ID NO: 4 at positions 277, 367, and 368 as recited for ORF40-1/SEQ ID: 4 in the '499 application, the PCT application, and the UK application.

9. The Certificate of Correction proposed by Scarlato seeks to replace the amino acids “X,” “b,” and “U” at positions 277, 367, and 368, respectively, with the amino acids “K,” “N,” and “I,” as well as other replacements of amino acid symbols in other sequences.⁴ (See Ex. 2021, Scarlato’s Proposed Certificate of Correction.)

III. Analysis

Under 35 U.S.C. 254, “[w]henver a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents.” If the request for a certificate of correction relates to a patent involved in an interference, the request also must be accompanied by a motion under Bd. 121(a)(2) or (3). 37 CFR § 1.322 (a)(3). On 01 September 2011 an Order was entered authorizing Scarlato to file the current miscellaneous motion. (Order – Authorizing Miscellaneous Motion – Bd. R. 104(a), Paper 53, at 2-3.) Peak did not file a request for rehearing of the Order authorizing the motion. Peak opposes the Scarlato Miscellaneous Motion (Paper 68) and Scarlato filed a Reply (Paper 69).

Scarlato requests that the “X,” “b,” and “U” symbols of the ORF40-1/SEQ ID: 4 sequence, as well as other sequences, be corrected in the ‘121 patent because typographical errors were introduced by the Office, allegedly as part of the scanning and printing process. (Scarlato Misc. Motion 1, Paper 55, at 1.)

⁴ Scarlato’s proposed Certificate of Correction also seeks to correct amino acids in the sequences at column 53, lines 1-53. (Ex. 2021.) Our opinion focuses on the proposed corrections concerning the ORF40-1/SEQ ID:4 since those could be relevant to this proceeding, but our reasoning applies to all the proposed changes.

Scarlato presents evidence showing that the sequence of ORF40-1/SEQ ID: 4 with “K,” “N,” and “I” instead of “X,” “b,” and “U” at positions 277, 367, and 368, was presented in the ‘499 application, which became the ‘121 patent, as filed, and also in the PCT and UK priority applications.⁵ (Scarlato Misc. Motion 1, pp. 2-4; FFs 2, 3, and 4; Ex. 2017, p. 66, Ex. 2015, PCT application, p. 62, and Ex. 2016, UK application, p. 63.) The prosecution history of the ‘121 patent shows that none of the sequences filed in the ‘499 application was amended after filing. (FF 5; Exs. 2018 and 2019.) Peak does not argue that Scarlato introduced the differences between the sequences by amendment or that they occurred by anything other than Office error.

The evidence submitted by Scarlato is persuasive that the specification had not been amended to introduce differences in the ORF40-1/SEQ ID: 4 after filing. Without persuasive evidence to the contrary, we are persuaded that the differences are clearly disclosed in the record as the fault of the Office.

Peak argues only that Scarlato’s motion is untimely and that a miscellaneous motion is not a proper way to seek correction of a patent. (Peak Opp. to Misc. Motion 1, Paper 68, at 1.) According to Peak, Scarlato should have sought correction of the differences in sequence immediately after the ‘121 patent issued on 11 May 2010. (*Id.* at 2.) Peak argues further that Scarlato has been aware of the differences for some time, at least by 9 March 2011, when Peak filed a paper in this proceeding indicating that it intended to challenge the priority benefit accorded to Scarlato of the UK

⁵ In regard to the other sequences Scarlato seeks to correct in the proposed Certificate of Correction (Ex. 2021), Scarlato presents evidence of the sequence originally filed on page 67, line 43, through page 68, line 43 of the ‘499 application. (See Scarlato Misc. Motion 1, pp. 3-4.)

application and the PCT application. (See Peak Reply to March 3, 2011 Order, Paper 24, filed 9 March 2011.) According to Peak, the request for correction is now too late to and should not have any effect in this interference.

In the Order authorizing Scarlato to file the current motion the Board determined that the Scarlato request was timely given the circumstances of the proceeding but that to the extent Scarlato did not act in a timely fashion it was in the interests of justice to allow Scarlato to file the motion under those particular circumstances (citing to Bd. R. 41.4 (b) (2)(Order at 3, Paper 53). Peak did not request rehearing of the Order and cannot now properly argue against the timeliness of the Scarlato request to file the current motion. At any rate Peak's further arguments regarding timeliness⁶ are not persuasive as discussed below.

Peak relies on *Southwest Software, Inc. v. Harlequin, Inc.*, 226 F.3d 1280, 1297 (Fed. Cir. 2000) and *Superior Fireplace Co. v. Majestic Products Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001), to argue that under 35 U.S.C. § 254 certificates of correction are ineffective in actions that have already commenced between parties. (Peak Opp. to Misc. Motion 1, Paper 68, at 4.) *Southwest* is not on point to the present situation. First, *Southwest* was an infringement action where Southwest was seeking damages on the basis of its patent which, in its published version, contained an error that would make it invalid. In contrast, this interference proceeding is not for determining whether Scarlato properly can assert its patent against Peak in an infringement action. This proceeding is for determining priority of invention so that the Office knows whether it

⁶ These further arguments were not considered in the Order authorizing the current motion.

may allow the Peak application despite the Scarlato patent. Secondly, Peak is not arguing that Scarlato's claims as issued are unpatentable but only that Scarlato is not entitled to benefit of an earlier application because of the error. Finally, SEQ ID NO: 4 is disclosed in the Sequence Listing of the Scarlato '121 patent without the errors Scarlato seeks to correct and thus there was no omission of necessary information as in *Southwest*. (See FFs 6-8; Ex. 2009, cols. 181-184.)

According to Peak, a belated correction would "change the nature of the interference to the detriment of Peak." (See Peak Opp. to Misc. Motion 1, Paper 68, at 4.) Peak does not explain how it would be disadvantaged, particularly given that SEQ ID NO: 4 was provided in the Sequence Listing to the '121 patent without differences from the ORF40-1/SEQ ID: 4 sequence provided in the '499, PCT, and UK applications. (See Scarlato Reply in Support of Misc. Motion 1 at FN 1.) Moreover, Scarlato has conceded that it is not entitled to priority benefit of the earlier filed applications (i.e., UK 9800760.2 (Ex. 1007) and UK 9819015.0 (Ex. 1006)) for reasons other than the error it seeks to correct such that it appears likely that Peak will be entitled to the relief it requests in its Motion 1 even if the correction is authorized. (See Scarlato Opposition 1, Paper 45 at 1.)

IV. Order

Upon consideration of the motion, and for the reasons given, it is ORDERED that Scarlato Miscellaneous Motion 1 is **GRANTED**.

FURTHER ORDERED that Scarlato is authorized to file the request for certificate of correction along with a copy of this Decision with the Correction Branch of the Office of Patent Publication.

/ss/ Richard E. Schafer
Administrative Patent Judge

ss/ Sally Gardner Lane
Administrative Patent Judge

cc (via electronic):

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TORCZON, *Administrative Patent Judge*, concurring.

I join the majority's excellent opinion, but I wish to note that Board Rule 121(a) provides, in part—

(2) *Responsive motions*. The Board may authorize a party to file a motion to amend or add a claim, to change inventorship, or otherwise to cure a defect raised in a notice of requested relief or in a substantive motion.

(3) *Miscellaneous motions*. Any request for relief other than a substantive or responsive motion must be filed as a miscellaneous motion.

Had Scarlato called its motion a *responsive motion* rather than a *miscellaneous motion*, there would have been no question about whether it was an appropriate attempt "otherwise to cure a defect raised in a notice of requested relief or in a substantive motion." Peak has not shown how it was prejudiced by the label applied to the type of motion Scarlato filed.